

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERNST ORTHMANN, KLAUS WULFF, PETER HOELTZENBEIN,
HELMUT JUDAT, HANS WAGNER, GOTTFRIED ZABY and
HERBERT HEIDINGSFELD

Appeal No. 95-4985
Application No. 08/164,227¹

ON BRIEF

Before CAROFF, PAK and WALTZ, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 12, all of the claims pending in the application.

¹ Application for patent filed December 7, 1993. According to the appellants, the application is a continuation-in-part of Application No. 08/008,957, filed January 26, 1993.

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APPEALED SUBJECT MATTER

The subject matter on appeal is directed to a process for the continuous production of polyurethane and polyurethane urea **prepolymers**. This subject matter is adequately described in claim 1 which is reproduced below.

1. In a process for the continuous production of polyurethane and polyurethane urea prepolymers by reaction of

- A) one or more organic polyisocyanates, with
- B) one or more isocyanate-reactive compounds having molecular weights of from 400 to 10,000 and being selected from the group consisting of polyhydroxy compounds, polyamine compounds, and mixtures thereof,
- C) optionally in the presence of one or more monofunctional compounds, and
- D) optionally in the presence of activators, stabilizers, lubricants and other additives,

with the quantities of reactive components being selected such that the equivalent ratio of isocyanate groups to isocyanate-reactive groups is from 11.1:1 to more than 1.5:1, the improvement wherein the components are combined in a nozzle which has a constriction and wherein

- a) either the isocyanate-containing components or the isocyanate-reactive components are passed axially through the constriction of the nozzle,
- b) the other components are introduced laterally into the stream of components passing through the constriction via several bores

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distributed over the periphery of and in
the walls of said constriction, and

- c) the resultant mixture passes through a pipe in
which the components react to form a product
stream.

PRIOR ART

The references of record relied upon by the examiner are:

Zaby et al. (Zaby)	5,117,048	May 26, 1992 (filed Dec. 14, 1988)
Orthmann et al. (Orthmann)	5,360,885	Nov. 1, 1994 (filed Dec. 07, 1993)

Sweeney, F. M, Introduction to Reaction Injection Molding,
Technomic Pub., pp. 90-101 (1979) (hereinafter referred to as
"Sweeney").

REJECTION

The appealed claims stand rejected as follows:

(1) Claims 1 through 12 under the judicially created
doctrine of obviousness-type double patenting as unpatentable
over the claims of U.S. Patent 5,360,885 (Orthmann);

and

(2) Claims 1 through 12 under 35 U.S.C. § 103 as
unpatentable over the combined disclosures of Zaby and
Sweeney.

DISCUSSION

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Having carefully considered all of the arguments and the evidence relied on by the examiner and appellants in support of their respective positions, we conclude that the examiner has not established a prima facie case of unpatentability either under the judicially created doctrine of obviousness-type double patenting or under 35 U.S.C. § 103. Thus, we will not sustain any of the above rejections. Our reasons for this determination follow.

DOUBLE PATENTING

A patent's disclosure cannot be considered as "prior art" in considering obviousness-type double patenting. See, e.g., In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Instead, the law of double patenting is concerned **only** with that which is claimed and thus involves an inquiry into what, if anything, has been claimed twice. See General Foods Corp. v. Studiengesellschaft Kohl mbH, 972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992). As noted in In re Braat, 937 F.2d 589, 592, 19 USPQ2d 1289, 1291-1292 (Fed. Cir. 1991):

Obviousness-type double patenting is a judicially created doctrine intended to prevent **improper**

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timewise extension of the patent right by prohibiting the issuance of claims in a second patent which are not "patentably distinct" from the claims of a first patent. See In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985). The doctrine has also been phrased as prohibiting claims in the second patent which define "merely an obvious variation" of an invention claimed in the first patent. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). (emphasis in original)

The examiner contends that the subject matter of claims 1 through 12 is no more than "an obvious variation" of an invention claimed in the patent issued to Orthmann. The examiner, however, does not explain why those skilled in the art would have been led to employ Orthmann's elastomer making process for making prepolymers, in spite of the significant differences between the compositions of the starting materials and the physical and chemical properties of the elastomer and the prepolymer involved. Compare In re Ochiai, 71 F.3d 1565, 1569-71, 37 USPQ2d 1127, 1131-32 (Fed. Cir. 1995). As correctly argued by appellants at page 6 of the Brief, the examiner simply has not supplied evidence sufficient to conclude that the instantly claimed prepolymer making process is an obvious variation of Orthmann's elastomer (rubber) making process.

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In view of the foregoing, we will not sustain the examiner's rejection of claims 1 through 12 under obviousness-type double patenting.

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OBVIOUSNESS

It is well settled that equivalency alone does not establish obviousness. See In re Scott, 323 F.2d 1016, 1019-20, 139 USPQ 297, 299-300 (CCPA 1963); In re Flint, 330 F.2d 363, 367-68, 141 USPQ 299, 302 (CCPA 1964). It is the teachings of the prior art taken as a whole which must provide a motivation or suggestion to combine the references. See Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) and Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 550-51 (Fed. Cir. 1985).

The examiner contends that the polyurethane and polyurethane urea prepolymer making process of claims 1 through 12 would have been obvious to those skilled in the art in view of Zaby and Sweeney. However, Zaby is directed to using a venturi-type mixing reactor to form polyisocyanates. It does not provide any suggestion whatsoever to employ the venturi type mixing reactor in a process for making the claimed prepolymers, which involves the reaction of materially different reactants than those required for forming polyisocyanates. Nor does Sweeney provide any suggestion to

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employ such reactor in a prepolymer making process. Absent
the appellants' own teachings we can think of no

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cogent reason why one of ordinary skill in this art would have been motivated to combine the disparate teachings of these references in the manner proposed by the examiner. As the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051,

5 USPQ2d 1434, 1438 (Fed. Cir. 1988) stated, "it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

In view of the foregoing, we will not sustain the examiner's rejection of claims 1 through 12 under 35 U.S.C. § 103.

CONCLUSION

For the above reasons, the decision of the examiner is reversed.

REVERSED

MARC L. CAROFF)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS

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Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

jrg

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Appeal No. 95-4985
Serial No. 08/164,227

Judge PAK

Judge WALTZ

Judge CAROFF

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DECISION: REVERSED

Send Reference(s): Yes No
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 1207

Index Sheet-2901 Rejection(s):

Acts 2: _____

Palm: _____

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